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09/753,514	01/04/2001	Yasuyuki Fujikawa	1506.1002 (JDH)	3098

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EXAMINER

SAIN, GAUTAM

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/753,514

Applicant(s)

FUJIKAWA, YASUYUKI

Examiner

Gautam Sain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

- 1) This is a NonFinal rejection in response to the amendments/remarks filed via RCE on 6/24/05.
- 2) Claims 1, 2, 4-15 are pending and rejected in this rejection. Claim 3 is cancelled.
- 3) The effective filing date is 2/4/00 (based on foreign priority).
- 4) Examiner withdraws the rejection under 35 USC 112 since Applicant corrected the indefinite claim language.
- 5) The Examiner withdraws the previous assertion of Claims 4 and 5 as Allowable Subject Matter based on further consideration in view of the amendments/arguments with the original specifications/drawings (see 103 rejection below).
- 6) Examiner introduces a new line of rejection under 35 USC 101.

***Continued Examination Under 37 CFR 1.114***

- 7) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/05 has been entered.

***Claim Rejections - 35 USC § 101***

- 8) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8-1) Claims 1, 2, 4-10,12-15 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 2, 4-10,12-15 set forth nonfunctional descriptive material but fail to set forth physical structures or materials comprising of hardware of a combination of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a "useful, concrete and tangible" result. For example, Claims 1, 2, 4-10,12-15 "system" reads on a mental construct/abstract idea or at best a computer program, per se. The claim language does not clearly define structural elements and is not tangibly embodied on a computer readable medium. Claims 1, 2, 4-10,12-15 are interpreted as software per se, abstract ideas or mental construct and not tangibly embodied on a computer readable medium or hardware.

***Claim Rejections - 35 USC § 103***

9) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9-1) Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwahara (US 6202072, filed Dec 1997).**

**Claim 4**, Kuwahara suggests the amendments to the claim "wherein said ... lower-order hierarchy", "said retrieving ... higher-order hierarchy" and "said structured document ... lower-order hierarchy" (ie., for conversion from plain text to an SGML document with

the document having a specific form by referring to the conversion table, using a document type definition, thereafter adding adding tags to data that is arranged in a hierarchical manner (where staff encompasses name and department date, as shown in fig 2) and the tags are flank the content data ("development" inputed in the position in between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output)

Kuwahara does not expressly teach "repetitive structure" but does suggest it, because Kuwahara teaches that the prior art teaches a repetitive structure (ie., conventional technology generates every time for the entire document type definition processing instead of only once)(col 2, lines 45-50), showing that the repetitive is already well known in the conventional art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to includes generating conversion tables every time (instead of once) as suggest in the prior art of conventional technology, providing the benefit correlating fields of the prototype document to tags of the document type definition when converting plain text to SGML (Kuwahara, col 2, lines 36-44).

**Claim 5**, Kuwahara suggests the amendments to the claim "wherein said ... lower-order hierarchy", (ie., for conversion from plain text to an SGML document with the document having a specific form by referring to the conversion table, using a document type definition, thereafter adding adding tags to data that is arranged in a hierarchical manner (where staff encompasses name and department date, as shown in fig 2) and

the tags are flank the content data ("development" inputed in the position in between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output).

Kuwahara teaches "said retrieving module extracts [ ] conincident with one higher order hierarchy" (ie., the conversion of a plain text document having a *specific* form to a SGML document; examiner interprets that in order to have a specific form, there must be some condition of specificity in order to perform the conversion which is found out from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that necessitates a structure for each of the fields – name, department, and address which are the elements – in conjunction with the teachings of Nakatsuyma (see details below))(Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output).

Kuwahara does not teach "each region", but does suggest it, because Kuwahara teaches that the prior art teaches a repetitive structure (ie., conventional technology generates every time for the entire document type definition processing instead of only once)(col 2, lines 45-50), showing that the repetitive is already well known in the conventional art and in order for the repetitive processing, different areas have to be processed as separate regions/areas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to includes generating conversion tables every time (instead of once) as suggest in the prior art of conventional technology, providing the benefit

correlating fields of the prototype document to tags of the document type definition when converting plain text to SGML (Kuwahara, col 2, lines 36-44).

**9-2) Claims 1, 2, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwahara (US 6202072, filed Dec 1997), in view of Nakatsuyama et al (US 5752021, issued May 1998).**

**Regarding claim 1**, Kuwahara teaches “a reading module ... an identifier thereof” (ie., SGML conversion form generation module SGML document read-in module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches “a retrieving module which refers to the extraction ... target electronic document” (ie., the conversion of a plain text document having a *specific* form to a SGML document; examiner interprets that in order to have a specific form, there must be some condition of specificity in order to perform the conversion which is found out from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that necessitates a structure for each of the fields – name, department, and address which are the elements – in conjunction with the teachings of Nakatsuyma (see details below)).

Kuwahara teaches “a structure document generating module ... the definition information” (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

Kuwahara suggests the amendments to the claim “wherein said ... lower-order hierarchy”, “said retrieving ... higher-order hierarchy” and “said structured document ...

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lower-order hierarchy" (ie., for conversion from plain text to an SGML document with the document having a specific form by referring to the conversion table, using a document type definition, thereafter adding adding tags to data that is arranged in a hierarchical manner (where staff encompasses name and department date, as shown in fig 2) and the tags are flank the content data ("development" inputed in the position in between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output).

Kuwahara does not expressly teach, but Nakatsuyama suggests "a condition of a pattern of a character string of plain text data as" (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama, providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

**Regarding claim 2**, Kuwahara teaches "a reading module ... an identifier thereof" (ie., SGML conversion form generation module SGML document read-in module)(col 5, lines 1-18, lines 59-65).



Kuwahara teaches “a retrieving module which refers to the extraction ... target electronic document” (ie., the conversion of a plain text document having a *specific* form to a SGML document; examiner interprets that in order to have a specific form, there must be some condition of specificity in order to perform the conversion which is found out from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that necessitates a structure for each of the fields – name, department, and address which are the elements – in conjunction with the teachings of Nakatsuyma (see details below)).

Kuwahara teaches “a structure document generating module ... the definition information” (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

Kuwahara suggests the amendments to the claim “said structured document ... lower-order hierarchy” (ie., for conversion from plain text to an SGML document with the document having a specific form by referring to the conversion table, using a document type definition, thereafter adding adding tags to data that is arranged in a hierarchical manner (where staff encompasses name and department date, as shown in fig 2) and the tags are flank the content data (“development” inputed in the position in between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50; Fig 2, “Document Type Definition”; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output)

Kuwahara does not expressly teach, but Nakatsuyama suggests “a condition of a pattern of a character string of plain text data as” (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama, providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

**Regarding claim 6, 7,** Kuwahara teaches “extraction condition ... whole region to be extracted” in claim 6 and “extraction condition ... end part thereof” in claim 7 (ie., Plain text document ... “document for Application” and corresponding end tag “document for application”)(fig 3, item c)(ie., correlation therebetween as one unit)(col 5, lines 60-65).

**Regarding claim 8, 9,** Kuwahara teaches “description pattern ... to be extracted” (ie., in the plain text document “application form for registering e-mail address”; data displayed)(Fig 3, item a; col 6, lines 23-26).

**Regarding claim 10,** Kuwahara teaches “extraction condition ... syntax element of the region to be extracted” (ie., text document is analyzed by software for syntax and tags indicating a ... obtained syntax)(col 1, lines 31-40).

**Regarding claim 11**, Kuwahara teaches “reading ... text format”, “reading ... identifier thereof” (ie., conversion form generation module, document read-in module)(col 5, lines 1-20, lines 59-63).

Kuwahara teaches “referring to ... reading step”, “extracting ... electronic document”, “combining the regions ... definition information” (ie., specific form .. concrete data ... name field, address field; data correlating)(col 6, lines 11-27; col 5, lines 20-30; fig 2; fig 7, item 5).

Kuwahara teaches “generating ... definition information” (col 8, lines 33-38; fig 8).

Kuwahara does not expressly teach, but Nakatsuyama teaches “a condition of a pattern of a character string of plain text data as” (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama, providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

**Regarding claim 12**, Kuwahara teaches *reading plain text data; reading definition information that defines a correlation between elements as basic units configuring a document structure of a structured document, and that defines, for each of*

*the elements [.] and an identifier thereof* (ie., SGML conversion form generation module SGML document read-in module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches *referring to the extraction condition per element that is defined by the reading definition information; extracting a region coincident with the per-element extraction condition referred to out of the processing target electronic document* (ie., prototype file of a plain text document)(col 5, lines 27, fig 2, item 105).

Kuwahara teaches *combining the regions extracted with respect to the respective elements in accordance with the correlation between the respective elements that is defined by the definition information* (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

Kuwahara does not expressly teach, but Nakatsuyama teaches *a condition of a pattern of a character string of plain text data as* (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama, providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

**Regarding claim 13**, Kuwahara teaches *generating the structured document by adding to each region an identifier defined by the definition information* (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

**Regarding claim 14**, Kuwahara teaches a *reading module that reads definition information defining a correlation between elements as basic units configuring the document structure, and defining, for each of the elements, [...] and an identifier thereof*, (ie., SGML conversion form generation module SGML document read-in module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches a *retrieving module which refers to the extraction condition per element that is defined by the definition information read by said reading module, and that extracts a region coincident with the per-element extraction condition referred to out of the processing target electronic document* (ie., prototype file of a plain text document)(col 5, lines 27, fig 2, item 105).

Kuwahara does not expressly teach, but Nakatsuyama teaches a *condition of a pattern of a character string of plain text as an extraction condition* (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama,

providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

**Regarding claim 15**, Kuwahara teaches a *structured document generating module that combines the regions extracted with respect to the respective elements by said retrieving module in accordance with the correlation between the elements that is defined by the definition information* (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

#### ***Response to Arguments***

Applicant's arguments filed 6/24/05 have been fully considered but they are not persuasive. Applicant argues (bottom, page 8) for Claims 1, 2, 11, 12, and 14 that the Kuwhara in view of Nakatsuyama do not teach the features of the claims *as amended*. The Examiner disagrees and provides a detailed rejection for the claims as amended (see above rejection for details).

Applicant argues (on page 9, top) that Kuwhara in view of Nakatsuyama does not teach the claimed limitations "retrieving ... document". The examiner disagrees and provides a more detailed explanation in the rejection (see above rejection). Applicant argues (on bottom of page 9) that Kuwhara in view of Nakatsuyama does not teach the amended claimed limitations "correlation ... hierarchy". The applicant is arguing the claims as amended, for which The Examiner disagrees and asserts a more detailed

rejection to address the amended portions of the limitations (see rejection above for details).

Applicant argues (on page 10) that Kuwahra teaches away from a reasonable chance of success because it teaches comparison comments. The Examiner disagrees because Applicant's claims do not preclude 'comparison of comments'. With a broad reasonable interpretation of the claims, converting "plain text data" encompasses comments. Thus the Examiner maintains the motivation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GS

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10/15/2005